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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,428	04/13/2004	Elizabeth Colbert	015291-137	4019
21839 7590 07/18/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER SMITH, MATTHEW J	
			ART UNIT 3637	PAPER NUMBER
			MAIL DATE 07/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,428

Applicant(s)

COLBERT ET AL.

Examiner

Matthew J. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6Oct04&15Aug05</u> . | 6) <input type="checkbox"/> Other: ____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-7, and 9-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4, 6-7, and 9-13 of copending Application No. 10/824,336. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 24-27, 30-39, and 43-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayambem et al. (6645291).

Ayambem et al. disclose a coating formulation comprising water; acrylic latex binder (col. 9, line 21) present in an amount of 0.5 to about 15% by weight; a filler having 60% by weight calcium carbonate (col. 5, line 16); a noncellulosic thickener (col. 6, lines 40-41) present in an amount of 0.05 to 50% by weight; a dispersant or sodium polyacrylate (col. 11, lines 39-40) present in an amount of 0.5 to 20% by weight; anti-cracking agent or mica (col. 8, line 39); 0.1 to 5% by weight workability agent or clay (col. 8, line 16); gypsum (col. 8, line 25); a construction assembly (col. 1, lines 13-18) for interior walls, comprising: skim coated drywall elements with drywall elements having at least one skim coat deposited on the drywall elements, the skim coat formed from the coating formulation; one jointing material and the one skim coat form, in the dry state, a substantially homogeneous outer surface on the substantially planar outer surface; the drywall elements are flat, prefabricated elements or gypsum wallboard; and the drywall element having a core of gypsum with lining paper and a coating layer formed of a skim coat deposited on the lining paper (col. 1, line 54).

This reference further discloses a method for the construction of interior walls comprising: assembling skim coated prefabricated drywall elements; the skim coated prefabricated drywall elements have a coating layer formed from a coating formulation comprising water, a binder, a filler of 60% by weight calcium carbonate, and a

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noncellulosic thickener; the coating layer formed of the skim coat deposited on the prefabricated drywall elements by a coating device; jointing adjacent prefabricated drywall elements with a jointing material to form joints; drying the jointing material; the jointing material and the skim coat form, in the dry state, a substantially homogeneous outer surface for the entire surface formed from both the jointing material and skim coated prefabricated drywall elements; the skim coat deposited after assembly of the skim coated prefabricated drywall elements; and the prefabricated drywall elements are gypsum wallboard.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to create a coating by using the Ayambem et al. disclosure to create the claimed coating without undue experimentation.

Claims 14-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayambem et al. in view of Podlas (5102462).

Ayambem et al. disclose the invention substantially as claimed but not water in an amount sufficient to provide a viscosity for the formulation of 300 to 450 cps.

Podlas describes adding thickener to water in an amount sufficient to provide a viscosity for the formulation of 300 to 450 cps (col. 2, line 65).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to create a coating with the proper amount of thickener to provide a viscosity of 300-450 cps in order to apply the coating

Claims 28, 29, 40, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayambem et al. in view of Deodhar et al. (6663979).

Ayambem et al. disclose the invention substantially as claimed but not skim coat having a thickness of between 5 and 60 mil, the substantially homogeneous outer surface having a level 5 finish, or the skim coat deposited on the prefabricated drywall elements by spraying during prefabrication of the drywall elements.

Deodhar et al. discuss a skim coat having a thickness of between 5 and 60 mil (col. 9, line 41); a substantially homogeneous outer surface having a level 5 finish (col. 4, line 35); and the skim coat deposited on the prefabricated drywall elements by spraying during prefabrication of the drywall elements (col. 8, line 12).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to create a coating with a 5-60 mil thickness, level 5 finish, and spray coated, as discussed by Deodhar et al., in order to improve appearance.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 571-272-7034. The examiner can normally be reached on T-F, 8-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lanna Mai
Supervisory Patent Examiner
Art Unit 3637



MJS *MJS*
12 July 2007